

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

20807-0003-01

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on November 4, 2005

Signature

Typed or printed name Holly J. Lawrence

Application Number

09/828,444

Filed

April 6, 2001

First Named Inventor

AVALLONE et al.

Art Unit

3621

Examiner

F. BACKER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record. 46,401

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Brian T. Sattizahn

Typed or printed name

(717) 232-8000

Telephone number

November 4, 2005

Date

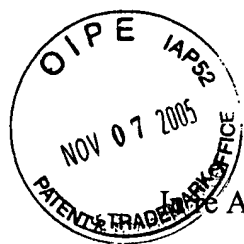
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: AVALLONE et al. :
: :
Application No.: 09/828,444 : Group Art Unit: 3621
: :
Filed: April 6, 2001 : Examiner: F. Backer
: :
For: METHODS AND SYSTEMS FOR PROVIDING PERSONALIZED INFORMATION
TO USERS IN A COMMERCIAL ESTABLISHMENT

PRE-APPEAL BRIEF REQUEST FOR REVIEW – SUPPORTING REASONS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal and a Pre-Appeal Brief Request for Review are being filed concurrently herewith in response to a Final Office Action dated June 13, 2005 and an Advisory Action dated October 18, 2005 in Application Number 09/828,444 (the "Application") in accordance with the procedures announced in the Official Gazette on July 12, 2005. Provided below is a succinct, concise and focused set of arguments supporting the request for the review and identifying clear errors in the Examiner's rejections or the Examiner's omission of one or more essential elements needed for a prima facie rejection.

REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected claims 44-80 under 35 U.S.C. 103(a) as being unpatentable over Anandan et al. (U.S. Patent Application Publication No. 2002/0062251), hereinafter referred to as "Anandan" in view of Engelke (U.S. Patent No. 6,594,346), hereafter referred to as "Engelke."

A. The Examiner has Omitted one or more Essential Elements

As discussed in more detail below and at pages 8-10 of the Response filed by Applicants on September 13, 2005 (the 9/13/05 Response), the rejection by the Examiner clearly omits one or more essential elements recited by Applicant in independent claims 44 and 68. In addition, as

discussed in more detail at pages 12-15 of the 9/13/05 Response, the rejection by the Examiner clearly omits one or more essential elements recited by Applicant in the dependent claims.

First, Anandan and/or Engelke do not teach or suggest a plurality of portable display units located in a commercial establishment for use by a plurality of users. The system in Anandan either provides the consumer with a personal device having an affixed tag in advance of the consumer entering the store (*See* Anandan, paragraph 0031) or attaches the tag to the consumer's own personal wireless device. *See* Anandan, paragraphs 0044 and 0045. The system in Engelke requires each user to have their own personal device with them before entering the store. *See* Engelke, column 4, lines 44-48. In fact, neither Anandan nor Engelke has a need for a plurality of portable display devices in a commercial establishment because each user in Anandan or Engelke already has a personal device before entering the commercial establishment.

The Examiner asserts that column 4, line 39 to column 5, line 47 of Engelke discloses a plurality of portable display units in a commercial establishment for use by a plurality of users as recited by Applicant. However, Applicant has identified no such teaching in the cited passage, or elsewhere, in Engelke and submits that Engelke does not teach this limitation for the reasons discussed in detail above.

Next, Anandan and/or Engelke do not teach or suggest that a user activates a portable display unit of the plurality of portable display units to operate in a commercial establishment by providing identifying information. The system in Anandan does not disclose a user activating the personal device and clearly does not disclose the user activating a personal device by providing personal information. The system in Anandan is able to identify the user by the tag that has been attached to the user's personal device. *See* Anandan, paragraphs 0045 and 0046. As such, the system in Anandan does not have any need to activate a personal device by providing identifying information as recited by Applicant because the tag attached to the user's personal device in Anandan is able identify the user. The system in Engelke does discuss the need for the user to activate the personal device, but Engelke does not disclose that the user activates the device by providing identifying information. The system in Engelke can be activated by pressing a start button without the need for providing any identifying information. *See* Engelke, column 4, lines 45-48.

The Examiner asserts that column 4, line 39 to column 5, line 47 of Engelke discloses that a user activates a portable display unit of the plurality of portable display units to operate in a commercial establishment by providing identifying information as recited by Applicant. However, Applicant has identified no such teaching in the cited passage, or elsewhere, in Engelke and submits that Engelke does not teach this limitation for the reasons discussed above.

B. The Examiner has made Clear Error in the Examiner's Rejections

As discussed in more detail below and at pages 10-12 of the 9/13/05 Response, the Examiner has clearly made one or more errors in the rejection of the claims.

Applicant respectfully submits that the Examiner has improperly combined Anandan and Engelke. The Examiner has provided no teaching or suggestion in Anandan that would indicate the desirability of incorporating into Anandan the personal interpreter of Engelke, nor has the Examiner cited any passage in Engelke that would indicate that the personal interpreter can be used in the device of Anandan. The Examiner makes a statement that one would be motivated to make the modification to ensure "on the spot communication between the user and the commercial establishment." However, the Examiner provides no support for this conclusion in either Anandan or Engelke. Furthermore, Applicant submits that the Examiner has already asserted that Anandan discusses this feature (*See* Final Office Action, page 3, lines 11-13), thus there would be no need to make the proposed combination as Anandan already has the feature to be added by the proposed combination with Engelke. Thus, Applicant respectfully submits that the Examiner has improperly combined Anandan and Engelke based on the teachings in Applicant's specification, which is impermissible hindsight reasoning by the Examiner.

Finally, Applicant submits that Engelke is non-analogous art with respect to Applicant's invention as recited in independent claims 44 and 68. Engelke is directed to the translation of information and communication between deaf and hearing persons. In contrast, Applicant's invention as recited in independent claims 44 and 68 is directed to a system and method for providing personalized information to a user in a commercial establishment. Applicant submits that one skilled in the art of providing personalized information to a user in a commercial establishment would not look to a reference directed to the translation of information and communication between deaf and hearing persons to solve problems in the field of providing


personalized information to a user in a commercial establishment. In addition, the Examiner has cited no passage in Engelke that would indicate that the translation of information and communication between deaf and hearing persons in Engelke would be suitable for use with providing personalized information to a user in a commercial establishment. Engelke is not in the same field endeavor as Applicant's invention nor is Engelke reasonably pertinent to the particular problems with which the inventor was concerned. As discussed above, Applicant submits that one skilled in the art of providing personalized information to a user in a commercial establishment would not look to a reference directed to the translation of information and communication between deaf and hearing persons to solve problems in the providing personalized information to a user in a commercial establishment field.

CONCLUSION

In view of the above, Applicant respectfully requests reconsideration of the Application and withdrawal of the outstanding rejections. The Examiner has made both clear errors and omitted essential elements in the rejection of the claims. Applicant submits that the Examiner has made clear error in combining Anandan and Engelke because Engelke is non-analogous and there is no motivation to combine Anandan and Engelke. Furthermore, the Examiner has omitted essential elements recited in the claims in the rejection based on Anandan and Engelke.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
McNEES WALLACE & NURICK LLC

By 
Brian T. Sattizahn
Reg. No. 46,401
100 Pine Street, P.O. Box 1166
Harrisburg, PA 17108-1166
Tel: (717) 237-5258
Fax: (717) 237-5300

Dated: November 4, 2005